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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/425,739	10/22/1999	CHARLES A. PEYSER	026624.0104PTUS	9954
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PATTON BOGGS, LLP 2001 ROSS AVENUE, SUITE 3000 DALLAS, TX 75201				
EXAMINER				
FADOK, MARK A				
ART UNIT		PAPER NUMBER		
3625				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/425,739

Applicant(s)

PEYSER ET AL.

Examiner

MARK FADOK

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 05 May 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1, 2 and 4-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
- Paper No(s)/Mail Date: \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date: \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 5/5/2009 has been entered.

The examiner has carefully considered applicant's arguments and amendment and finds them convincing in regards to the rejection on the merits however after further search and consideration the following new ground of rejection necessitated by amendment follows:

***Priority***

The later-filed application must be an application for a patent for an invention, which is also disclosed, in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 60/138,509, fails to provide adequate support or enablement in the manner provided by the first paragraph

of 35 U.S.C. 112 for one or more claims of this application. In this case the provisional application does not provided support for bidding in "spot markets" as described in the claims and specification pages 18 and 19 with particular attention to the feature preventing the requester from accepting the identical response after the session is terminated.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 1,2,4,6-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Telezoo (a series of articles from PTO 892) in view of Johnson (US 6,047,274).**

**In regards to claim 1**, Telezoo discloses a system computer implemented method for facilitating the purchase of telecommunication services, the system comprising:

a server in communication with a plurality of buyer terminals and a plurality of seller terminals Telezoo, page 1),

wherein said server performs a method stored in a storage medium and executed by one or more processors, comprising:

storing in memory information associated with one or more of a plurality of telecommunication service providers (telezoo, page 2, second para),

the information being used to determine one or more responses to a request to purchase at least one telecommunication service (telezoo, page 2, para 3),

Telezoo teaches each of the one or more responses being associated with at least one of the plurality of telecommunication service providers and each of the one or more responses being further associated with a related cost for the at least one telecommunication service, but does not specifically mention an indication associated with the seller controlled geographic footprint wherein the telecommunication service is available determining the at least one response in response to the received request based at least upon the indication associated with the seller controlled geographical footprint. Johnson teaches that providers may limit the bids that are provided to them based on geographic region (col 7, lines 5-15, col 1, lines 35-40, col 13, lines 55-60). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Telezoo an indication associated with the seller controlled geographic footprint wherein the telecommunication service is available determining the at least one response in response to the received request based at least upon the indication associated with the seller controlled geographical footprint as is taught by Johnson, because this will allow a provider to indicate an unwillingness to provide the

service to an end user, thereby saving time providing bids to areas that the provider does not service (Johnson col 1, lines 35-40).

Telezoo teaches establishing a session by a connection made through the internet and receiving a request for the purchase of at least one telecommunication service after the information associated with one or more of a plurality of telecommunication service providers is stored (one to one comparisons), but does not specifically mention preventing a requester from accepting the identified response after the session is terminated. Johnson in an auction environment where bids are received on time sensitive services, Johnson teaches preventing a requester from accepting the identified response after the session is terminated (col 12, para 35-55). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include preventing a requester from accepting the identified response after the session is terminated because the supplier may wish to change the provided bid as they may feel that the service is commanding a higher or a lower price and would therefore increase revenues and profits by not providing bids that are perpetual (Johnson, col 13, lines 35-45).

**In regards to claim 2**, the combination of Telezoo and Johnson teaches terminating the session (Johnson col 12-13, bids are terminated after a time period is set for the bidding session).

**In regards to claim 4**, the combination of Telezoo and Johnson teaches permitting access by telecommunication service providers to the stored information during the session (Telezoo page 2 update information immediately without having to wait, and Johnson col 13, lines 35-45 and col 20, lines 15-20).

**In regards to claim 6**, the combination of Telezoo and Johnson teaches denying access by a telecommunication service provider, during the session, to the stored information,

wherein the response to which access is denied is the same as the at least one response (Johnson col 18, lines 30-40, Bid information on price and provided is stored so that billing may be effected by the moderator).

**In regards to claim 7**, the combination of Telezoo and Johnson teaches permitting each telecommunication service provider to modify the stored information to reflect changes in the at least one telecommunication service provided by the service provider (Telezoo page 2 update information immediately without having to wait, and Johnson col 13, lines 35-45 and col 20, lines 15-20).

**In regards to claim 8**, Telezoo discloses a system for provisioning telecommunication service, comprising:

a database containing a set of responses to purchase requests for telecommunication services,

each response reflecting at least one telecommunication service offering associated with a telecommunication service provider,

a related cost for the telecommunication service offering, and

an indication associated with the seller controlled geographic footprint wherein the telecommunication service is available,

each response being determined based at least upon the indication associated with the seller controlled geographical footprint;

a computer in communication with a network and the database comprising a set of instructions, stored in a tangible medium and executed by one or more processors, performs a method comprising the steps of:

(i) receiving a purchase request on behalf of a buyer including information indicating a requested telecommunication service for at least one consumer,

(ii) accessing the stored set of responses to purchase requests for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service for the at least one consumer,

(iii) receiving an acceptance to the response during the session; and

(iv) preventing the acceptance to the response after the session is terminated (see response to claim 1).



**Claims 5 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Telezoo (a series of articles from PTO 892) in view of Johnson (US 6,047,274) and further in view of Shoham (US 6,584,451).**

**In regards to claim 5**, the combination of Telezoo and Johnson teach storing bid information (Johnson col 18, lines 30-40, Bid information on price and provided is stored so that billing may be effected by the moderator). , but does not specifically mention denying access by the telecommunication service providers to the stored information during the session (Johnson col 18, lines 30-40, Bid information on price and provided is stored so that billing may be effected by the moderator). Shoham in the field of electronic auctions teaches denying the providers access to the stored information during a session (Shoham, col 5, line 62 - col 6, line 8). It would have been obvious to a person having ordinary skill in the art at the time of the invention to include in Telezoo and Johnson denying the providers access to the stored information during a session, because this will allow persons that have accepted the bid to feel confident that the provider will honor the agreed to price that was accepted during the session (Shoham, col 6, line 4-6).

**In regards to claim 9**, Telezoo Johnson and Shoham disclose a system computer implemented method for purchasing telecommunication services during a session, the system comprising:

a server in communication with a plurality of buyer terminals and a plurality of seller terminals,

wherein said server performs a method stored in a storage medium and executed by one or more processors, comprising:

storing a set of responses in memory to purchase requests for telecommunication services,

each response reflecting at least one telecommunication service offering associated with a telecommunication service provider,

a related cost for the telecommunication service offering, and an indication associated with the seller controlled geographic footprint wherein the telecommunication service is available,

each response being determined based at least upon the indication associated with the seller controlled geographical footprint:

receiving a purchase request at a computer on a network during the session including information indicating a requested telecommunication service;

accessing the stored set of responses to purchase requests during the session for at least one response reflecting at least one telecommunication service offering capable of satisfying the requested telecommunication service;

permitting a requestor to accept the at least one response during the session;

preventing the requestor from accepting the at least one response after the session is terminated; and

preventing the telecommunication service provider from modifying the set of responses during the session (see response to claims 1 and 5).

### ***Response to Arguments***

Applicant's arguments with respect to claims 1, 2, 4-9 have been considered but are moot in view of the new ground(s) of rejection.

Applicant argues that the priority was addressed in the response filed 12/17/2002. The examiner notes that the previous response only added the reference to the provisional application and does not address that the features noted supra are found in the provisional. Therefore, since the instant independent claims contain features that are not found in the provisional applicant is only granted the priority date of the non-provisional which is 10/22/1999.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Mark Fadok** whose telephone number is **571.272.6755**. The examiner can normally be reached Monday thru Friday 8:00 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Jeffrey Smith** can be reached on **571.272.6763**.

Any response to this action should be mailed to:

***Commissioner for Patents***

***P.O. Box 1450***

Alexandria, Va. 22313-1450

or faxed to:

**571-273-8300** [Official communications; including

After Final communications labeled

"Box AF"]

For general questions the receptionist can be reached at

571.272.3600

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/Mark Fadok/  
Mark Fadok  
Primary Examiner